Supreme Court, U.S.
FILED
AUG 7 2001
OFFICE OF THE CLERK

No. 01-95

IN THE

Supreme Court of the United States

KIMBERLY-CLARK CORPORATION,

Petitioner,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY, INBRAND CORPORATION,
and CONFAB, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

JOHN M. SKENYON
Counsel of Record
ALAN D. SMITH
FISH & RICHARDSON P.C.
Attorneys for Respondents
225 Franklin Street
Boston, MA 02110
(617) 542-5070

168528

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

COUNTERSTATEMENT OF THE QUESTIONS PRESENTED

1. Whether an opinion of the Court of Appeals for the Federal Circuit, which has been designated as nonprecedential by that Court, can be cited and followed as precedent in future cases.

2. Whether the district court and the Court of Appeals for the Federal Circuit erred when they followed established law and interpreted the claims of the patents-in-suit as excluding the prior art disclaimed by the applicant during prosecution of the patent applications, which resulted in the issuance of the patents-in-suit.

STATEMENT PURSUANT TO RULE 29.6

Respondents, The Kendall Company and Inbrand Corporation, are wholly owned by Respondent Tyco International (US), Inc. Respondent, Tyco International (US), Inc., is wholly owned by The Tyco International Ltd. which is a publicly held company.

TABLE OF CONTENTS

	Page
Counterstatement of the Questions Presented	i
Statement Pursuant to Rule 29.6	ii
Table of Contents	iii
Table of Cited Authorities	v
Introduction	1
Restatement of the Case	2
A. Kimberly-Clark Disclaimed Fluid Impervious Flaps In the Prosecution Of Its Enloe Patents	2
B. The Patent Office Expressly Excluded Fluid Impervious Flaps From the Lawson Interference	4
C. The Respondents Use Fluid Impervious Flaps	8
Reasons for Denying the Writ	9
I. The Nonprecedential Federal Circuit Opinion Cannot, As A Matter Of Law, Be Relied Upon In Later Cases	9

Contents

Page

II. The Federal Circuit Correctly Cited And Followed Established Claim Construction Law When Interpreting The Enloe Claims 11

A. The Federal Circuit Did Not Use A New Methodology 11

B. The Reference In The Enloe Specification To Fluid Pervious Material As Preferred Is Not Disclosure Of Fluid Impervious Material 14

C. Claim 26 Of Enloe II Was Not Directed To Fluid Pervious Flaps 15

D. The Federal Circuit Properly Interpreted The Claims Copied As A Result Of The Interference 16

Conclusion 19

TABLE OF CITED AUTHORITIES

Page

Cases:

Computing Scale Co. of America v. Automatic Scale Co., 204 U.S. 609 (1907) 13

Corbin Cabinet Lock Co. v. Eagle Lock Co., 150 U.S. 38 (1893) 13

Cultor Corp. v. A.E. Staley Mfg. Co., 224 F.3d 1328 (Fed. Cir. 2000) 16, 17, 18

In re Paulsen, 30 F.3d 1475 (Fed. Cir. 1995) 12

In re Spina, 975 F.2d 854 (Fed. Cir. 1992) 16, 18

Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985 (Fed. Cir. 1999) 12

Lehigh Valley Ry. Co. v. Kearney, 158 U.S. 461 (1895) 13

McCarthy v. Lehigh Valley R.R., 160 U.S. 110 (1890) 12

O.I. Corp. v. Tekmar Co., 115 F.3d 1576 (Fed. Cir. 1997) 14, 16

Royer v. Coup, 146 U.S. 524 (1892) 13

Tandon Corp. v. U.S. Int. Trade Commission, 831 F.2d 1017 (Fed. Cir. 1987) 16

Cited Authorities

Page

Tronzo v. Biomet, Inc., 156 F.3d 1154 (Fed. Cir. 1998) 14

Weber Elec. Co. v. Freeman Elec. Co., 256 U.S. 668 (1921) 12

Rules:

Fed. Cir. R. 47.6(b) 1, 10

Fed. Cir. R. 47.6(c) 11

The Respondents respectfully request that this Court deny the petition for a writ of certiorari. The decision below is not in conflict with any decisions of this Court or of the Federal Circuit. Instead, it follows the long-established law of interpreting patent claims to exclude prior art that the patent applicant has distinguished and disclaimed during the prosecution of its patent application. In addition, contrary to the Petitioner's assertion, the opinion below does not create a new methodology of claim construction rendering that task unpredictable in future patent cases. In fact, the Federal Circuit expressly designated its opinion as nonprecedential under its Rule 47.6(b), which precludes the opinion from being cited as precedent in any other case.

INTRODUCTION

The petition here not only omits key facts relied upon by both the district court and the Federal Circuit in reaching their decisions, but it also mischaracterizes the Federal Circuit's treatment of the claim construction issue, which the Petitioner erroneously describes as an arbitrary reading of a limitation from the patent specification into the claims. In reality, the "limitation" in question is prior art which the Petitioner expressly disclaimed early on in the lengthy prosecution of the patents-in-suit. In properly construing the claims at issue, the Federal Circuit below followed the previous decisions of both this Court and the Federal Circuit, which make it clear that when a patent applicant disclaims subject matter during the prosecution of its patent application, it cannot later "recapture" the disclaimed subject matter for the purposes of proving infringement in a litigation.

RESTATEMENT OF THE CASE

A. Kimberly-Clark Disclaimed Fluid Impervious Flaps In the Prosecution Of Its Enloe Patents

The case below involved three patents ("the Enloe patents"), all based on a common parent application and all having a common prosecution history. The invention covered by the claims of all three Enloe patents is a diaper with flaps, which flaps are intended to trap solid or partially solid bodily waste so that it does not leak out the sides of the diaper (JA 95, col. 1, lines 16-21; col. 4, lines 63-67; JA 4, 91).[1] There are two types of diaper flaps: fluid pervious ones and fluid impervious ones.

The original Enloe patent application was filed on July 2, 1984, and its broadest claim covered both types of flaps (App. 2-3a).[2] However, in the very first Office Action, the Examiner rejected the broadest claim as being anticipated by the prior art Beckestrom patent, which disclosed a diaper with fluid impervious flaps. As the Federal Circuit correctly noted below, the Petitioner made absolutely no attempt to argue that this anticipation rejection was incorrect in any way (App. 3a).

Instead, the Petitioner immediately abandoned the original Enloe application and filed the continuation-in-part application which later became the first Enloe patent ("Enloe I") (App. 3a). In order to overcome the Beckestrom

1. As in the Petition, these citations to "JA" refer to materials found in the Joint Appendix filed in the Federal Circuit appeal.

2. The reference is to the Appendix filed here as part of the Petition.

prior art with its fluid impervious flaps in the new application, the Petitioner added three paragraphs to the specification. The first described the prior art Beckestrom patent with fluid impervious flaps (JA 6, 16). The second, which immediately followed, explained a problem associated with fluid impervious flaps (App. 3a), and finally, in the third new paragraph, the Petitioner described the Enloe invention as being just *fluid pervious* flaps, which solved the problem created by the fluid impervious flaps of the prior art (App. 3a). The only flap material actually disclosed in the new Enloe I specification was fluid pervious material (App. 4a), and all the new claims submitted by the Petitioner with the new Enloe I application were expressly limited to fluid pervious flaps (App. 4a). Both the district court and the Federal Circuit correctly characterized all this as a disclaimer by the Petitioner of fluid impervious flaps (App. 5a). And the disclaimer was successful. With some other minor amendments, the Examiner then allowed the Enloe I claims, noting that a key to allowance was the limitation of the claims to fluid pervious flaps (JA 6, 2976-7).

The Petitioner does not appear to disagree with the district court's and Federal Circuit's characterization of all this as a disclaimer of fluid impervious flaps, at least for Enloe I (Petition at 17). [3] Rather, the Petitioner contends that it set out to and later recaptured in the related Enloe II and Enloe III applications the fluid impervious flaps it disclaimed in Enloe I. Both the district court and the Federal Circuit, however, correctly concluded that the Petitioner's alleged recapture attempt was largely illusory and entirely unsuccessful.

---

3. The Petitioner refers to lawsuit involving the Enloe I patent and Procter & Gamble (Petition at 8). For much the same reasons, the district court in that case also concluded that the Petitioner had disclaimed fluid impervious flaps in Enloe I (JA 2012-3, 2017-18).

In fact, both the district court and the Federal Circuit found that the Petitioner took affirmative steps to be sure that this disclaimer of the fluid impervious flaps carried over into the continuation applications that became the Enloe II and Enloe III patents in order to ensure the continued successful avoidance of the troublesome prior art Beckestrom patent. In particular, the Petitioner intentionally kept the same three paragraphs added to Enloe I, which paragraphs were successfully used to distinguish Beckestrom in all the subsequent Enloe specifications. As the Federal Circuit said (App. 4a):

> During the prosecution of Enloe II and Enloe III, Enloe never sought to remove or amend that language, nor to traverse, appeal, or submit arguments seeking to overcome the initial rejection [based on Beckestrom] on other grounds.

In fact, aside from one unsuccessful attempt in the Lawson interference discussed below, nowhere in the twelve years of prosecution from the time the Enloe I application was filed in 1985 to the issuance of the Enloe III continuation in 1997 did the Petitioner ever make any attempt to recapture the fluid impervious flaps it had clearly disclaimed in Enloe I (App. 7a).

B. The Patent Office Expressly Excluded Fluid Impervious Flaps From the Lawson Interference

The Enloe II continuation application was filed by the Petitioner in February, 1989 (JA 3535-59), and all of its claims were expressly limited to fluid pervious flaps (JA 3570-5). The Petitioner did not seek to try to "recapture" fluid impervious flaps then. Instead, it described these new

fluid pervious flap claims as "more particularly point[ing] out and distinctly claim[ing] applicant's invention" (JA 3575).

On October 20, 1989, the Patent Office declared an interference between the then pending Enloe II application with all its claims limited to fluid pervious flaps and a Procter & Gamble patent to Lawson, which had claims covering both fluid pervious and fluid impervious flaps (JA 3580-82; 2407-2418). An interference determines who is the first inventor of an invention, but the "invention" in dispute is actually defined by the Patent Office in what is called the "count" of the interference. In this interference, the Patent Office defined the count as corresponding to the fluid pervious flap claims of the Enloe II application as well as some claims of the Lawson patent. Notably, the Patent Office specifically *excluded* from the count all the Lawson claims directed to fluid impervious flaps (see JA 3582, 2417-8, Lawson claims 13, 17, 21, 25, 27).[4]

After the interference was declared, the Petitioner amended its claims in Enloe II by copying into its application the claims from the Lawson patent which corresponded to the count (JA 3584-91). These, with later modifications not important here, were to become the issued claims of Enloe II and Enloe III. Unlike the Petitioner's claims, the copied Lawson claims did not specifically refer to the flaps as being fluid pervious. While the Petitioner now insists that these claims of Enloe II (and Enloe III) cover fluid impervious flaps, that is not what the Petitioner told the Patent Office at that time. On the contrary, the Petitioner immediately

---

4. The Lawson patent uses the term "barrier cuffs" for flaps. The parties have treated the terms as interchangeable in this case.

recognized that even though the copied Lawson claims corresponding to the count did not use the words fluid pervious in relation to the flaps, these claims did *not* cover fluid impervious flaps. The Petitioner tried to fix that, however. It immediately filed a motion with the Patent Office to amend the count to add Lawson's fluid impervious flap claims to the interference (JA 7473-76). In its motion, the Petitioner admitted that the Lawson claims to fluid impervious flaps were *different* than the claims corresponding to the count, but the fluid impervious flap claims should be included in the interference because they would be *obvious* in view of the claims of the count (JA 7475-6). The Patent Office, however, denied the Petitioner's motion.

The Petitioner now says that its motion was denied for reasons "unrelated to whether Enloe's pending application supported a generic claim to diapers with flaps" (Petition at 9), but that is only partially correct. The Patent Office held (JA 8742-52, at 8744-5):

> In the Motion, Enloe requests that claims 13, 17, 21, 25, 27 and 28 of Lawson be designated as corresponding to the count. *These claims call for the [flaps] to be [fluid impervious]. In order to be properly designated as corresponding to the count, these claims must be to the same invention (35 USC 102) as the count or obvious (35 USC 103) in view of the count* (37 CFR 1.601(n) and 1.637(c)(3)(ii)). Since these claims were not designated as corresponding to the count on declaration of the interference the burden is on Enloe to show that they are for the same patentable invention as the count. ***The claims are not anticipated by the count*** *and Enloe has made no*

> *attempt to show that the subject matter of these claims would have been obvious from the subject matter of the count or that subject matter in view of other prior art.*

In sum, even though the claims of the count copied by the Petitioner from the Lawson patent did not refer specifically to the flaps as being fluid pervious, those claims, as the Patent Office defined them for the interference and as the Petitioner recognized at the time, did *not* cover fluid impervious flaps. The Petitioner never raised the Patent Office's interpretation of the count as excluding fluid pervious flaps at final hearing in the interference, and it never appealed this adverse ruling. Thus, when the Petitioner won the right to prosecute claims corresponding to the count of the interference (JA 12108), it only won the right to further prosecute claims corresponding to the count as defined by the Patent Office, and that clearly *excluded* claims to fluid impervious flaps, as the Federal Circuit correctly ruled (App. 7a):

> Although Enloe originally specified "fluid pervious" flaps in the application that became Enloe II, he deleted the reference in the claims to "fluid pervious" flaps at the time of the interference in order to copy the claims of the Lawson patent. There is no suggestion in the prosecution history that the deletion of that language had the effect of recapturing fluid impervious flaps.
>
> Indeed, the exclusion of Lawson's fluid impervious claims from the interference, and the denial of Enloe's motion seeking to add those

> claims, indicates that the examiner and the Board of Patent Appeals and Interferences understood that Enloe had disclaimed fluid impervious flaps notwithstanding the omission of the express references to fluid pervious flaps.

Subsequently, the only reason the claims in Enloe II and Enloe III do not expressly call for the flaps to be fluid pervious is because they are based upon the Lawson claims the Petitioner copied. And as the Patent Office, Procter & Gamble and the Petitioner all agreed at that time, those claims did not cover fluid impervious flaps.

In terms of the entire Enloe prosecution, the Petitioner continually and repeatedly disclosed fluid impervious flaps as prior art, which it overcame in each Enloe application, including Enloe II and Enloe III, by first adding to and always keeping in its patent specifications the language that described the Enloe invention as being limited to fluid pervious flaps. The Patent Office was of the same opinion in the interference. The Petitioner's current position, however, is as if it had removed this language from the specifications of Enloe II and Enloe III and won its motion to add the fluid impervious claims to the interference count (App. 7a).

C. The Respondents Use Fluid Impervious Flaps

The Respondents also make and sell diapers with flaps, which are fluid impervious flaps and licensed under the Lawson patent, which still kept its fluid impervious flap claims after the interference with Enloe II (JA 1198, 188, 8, 2281-3). The Petitioner, nevertheless, charged the Respondents with infringement of all three Enloe patents.

Thus, the Petitioner's only real attempt to recapture this disclaimed subject matter did not occur in the prosecution of the Enloe patent applications, but rather only in this litigation.

REASONS FOR DENYING THE WRIT

This case does not warrant further review. Although the Petitioner argues that the decision below will dramatically alter the course of patent law, the Federal Circuit's decision was expressly designated as nonprecedential because both the district court and the Federal Circuit followed such well-established law that the opinion does not add to that body of law in any way.

I. The Nonprecedential Federal Circuit Opinion Cannot, As A Matter Of Law, Be Relied Upon In Later Cases

The Petitioner contends that the Federal Circuit "abandoned long-settled principles governing construction of patent claims" (Petition at 3) and in so doing "undermined the certainty and predictability that are essential to the technological innovation and development that the patent laws are designed to promote". (Petition at 4). The Petitioner goes on to argue that the Federal Circuit selectively and arbitrarily read something from the patent specification ("fluid pervious") into the claims of Enloe II and Enloe III, in what the Petitioner erroneously contends is a fundamental change in the rules of claim construction with far reaching affects. According to the Petitioner, (Petition at 13):

> In addition to the impact on future inventions and patents, the court's fundamental changes in the

> rules of claim construction distorts the value of bargains struck in scores of assignments, licensing agreements, and other transactions based upon what were previously understood to be clear and settled patent rights.

The Petitioner then goes on to predict that, as a result of the Federal Circuit's decision here, inventors will undoubtedly minimize any discussion of the preferred embodiment in their patent applications in the future (Petition at 13), which will keep information out of the public domain (Petition at 14).

The first fundamental flaw in this argument is an undisputed fact that the Petitioner neglects to tell this Court. While the Petitioner refers to the Federal Circuit opinion below as "unreported", the Petitioner fails to mention anywhere in its Petition that the decision below was expressly designated as *nonprecedential* by the Federal Circuit under its Rule 47.6(b).[5] That Rule reads:

> (b) **Nonprecedential Opinion and Order.** An opinion or order which is designated as not to be cited as precedent is one unanimously determined by the Federal Circuit issuing it as not adding significantly to the body of law. *Any opinion or order so designated must not be employed or cited as precedent.* This rule does

5. The actual opinion of the Federal Circuit in the case bears the legend that "[p]ursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. This disposition will appear in tables published periodically". This legend has been redacted from the first page of the opinion as it is reproduced in the Petitioner's Appendix.

> not preclude assertion of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like based on a decision of the court designated as nonprecedential.[6]

Neither party requested this Federal Circuit's opinion be reissued as precedential, as permitted by Rule 47.6(c) of the Federal Circuit, and the time for so doing has expired. The Federal Circuit, as a whole, did not disagree with the designation of the opinion as nonprecedential, as it not only denied the Petitioner's petition for rehearing and rehearing en banc below, but it designated its denial as nonprecedential as well (App. 69a). Thus, as a matter of law, the writ of certiorari is being sought here in connection with an opinion which cannot be cited or relied upon for any purpose in any other case. Indeed, it cannot be cited even by the Federal Circuit itself in later cases. Nevertheless, the decision followed the established law of this Court and of the Federal Circuit.

II. The Federal Circuit Correctly Cited And Followed Established Claim Construction Law When Interpreting The Enloe Claims

A. The Federal Circuit Did Not Use A New Methodology

According to the Petitioner, the Federal Circuit began its claim analysis with the specification rather than the claims thus demoting claim language to a "secondary place" in a claim construction analysis (Petition at 11, 13). This is not correct. The Federal Circuit reproduced claim 1 of Enloe I

6. Unless otherwise noted, it is our emphasis that is added here and throughout.

at the outset of its opinion (App. 4a), and thereafter, the Court focused on the question of whether or not the word flaps (or its equivalent) in the Enloe II and Enloe III claims should be interpreted as being limited to fluid pervious ones (App. 5a-8a). The claims were never ignored by the Court nor were they treated as secondary. Instead, the Federal Circuit followed the same treatment of them as did the Petitioner in its brief below.

The Petitioner then contends that the Federal Circuit improperly read a limitation ("fluid pervious") from the specification into the claims of Enloe II and Enloe III. In its Petition, it cites several cases about the general prohibition against reading limitations into claims where there is no disclaimer. For example, the Petitioner cites *Johnson Worldwide Associates, Inc. v. Zebco Corp.*, 175 F.3d 985 (Fed. Cir. 1999) for the proposition that the written description of a patent will not ordinarily narrow the claims. It also cites *In re Paulsen*, 30 F.3d 1475 (Fed. Cir. 1995) and *McCarthy v. Lehigh Valley R.R.*, 160 U.S. 110, 116 (1890) to the same effect.

While these and other cases stand for a general principal relating to claim construction, the black letter law has long been that the patentee is not permitted to disclaim something during prosecution (*e.g.*, fluid impervious flaps) and then (usually when confronted by a competitor practicing that prior art) contend that its patent claims still somehow cover what it disclaimed to get its claims allowed. *See for example, Weber Elec. Co. v. Freeman Elec. Co.*, 256 U.S. 668, 677-678 (1921) ("having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had

without the amendments . . ."); *Computing Scale Co. of America v. Automatic Scale Co.*, 204 U.S. 609, 617 (1907) ("it is perfectly well settled in this court by frequent decisions that where an inventor, seeking a broad claim which is rejected, in which rejection he acquiesces, substitutes therefore a narrower claim, he cannot be heard to insist that the construction of the claim allowed shall cover that which has been previously rejected"); *Lehigh Valley Ry. Co. v. Kearney*, 158 U.S. 461, 465 (1895) ("the rule is that where the applicant acquiesces in the rejection of claims by the Patent Office or in a construction which narrows or restricts them . . . the claim must be confined and restricted to the particular device described"); *Corbin Cabinet Lock Co. v. Eagle Lock Co.*, 150 U.S. 38, 40 (1893) ("having originally sought broader claims, which were rejected, and having acquiesced in such rejection, and having withdrawn such claims, and substituted therefore this narrower claim, describing a particular or specific lock, as such, neither the patentee nor his assignees can be allowed, under the authorities, to insist upon such construction of the allowed claim as would cover what had been previously rejected"); *Royer v. Coup*, 146 U.S. 524, 532 (1892) ("a patentee cannot successfully contend that his patent shall be construed as if it still contained the claims which were . . . rejected and withdrawn").

This is precisely what the Petitioner did twice. First, it abandoned its original patent application and limited its claims to fluid pervious flaps in the face of the original Beckestrom rejection; secondly, it acquiesced in and did not appeal from the Patent Office's denial of its motion in the interference to add the claims directed to fluid impervious flaps.

The Federal Circuit also follows the same rule of law, and in the opinion below, the Court correctly cited some of those cases, including *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998) and *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581 (Fed. Cir. 1997), where the specifications of the respective patents similarly disclaimed certain prior art structures, which could not later be recaptured by the patentees in litigation, regardless of otherwise broad claim language. These cases are ignored by the Petitioner. In short, the Federal Circuit followed existing precedent in how it approached the claim construction issue and how it decided the issue.

B. The Reference In The Enloe Specification To Fluid Pervious Material As Preferred Is Not Disclosure Of Fluid Impervious Material

The Petitioner also points to two things considered by both the district court and the Federal Circuit but determined by both courts to be insufficient to erase its disclaimer of fluid impervious flaps. None of the Enloe patent specifications disclose any fluid impervious material for the flaps or even say that the flaps could be made of fluid impervious material. However, the Petitioner notes that the specifications of the Enloe II and Enloe III patents refer to the fluid pervious material for the flaps as being "preferred". According to the Petitioner, this is somehow an affirmative disclosure of fluid impervious flap material for its invention. The Federal Circuit, however, correctly noted that the same "preferred" language appeared in the Enloe I specification where the fluid impervious flaps were clearly disclaimed. The Federal Circuit concluded that the same carry-over use of the word "preferred" in Enloe II and Enloe III could not eliminate the disclaimer (App. 6-7a):

> Because that statement, when made in the Enloe I specification, plainly did not mean that the claims

> of that patent should be read to include fluid pervious flaps, it cannot reasonably be read to have assumed a different meaning when it was carried over into the specifications of Enloe II and Enloe III. *See Abtox, Inc. v. Exitron Corp.*, 131 F.3d 1009, 1010, 46 USPQ2d 1735, 1735-36 (Fed. Cir.), *modifying* 122 F.3d 1019, 43 USPQ2d 1545 (Fed. Cir. 1997) (improper to construe the same term in related patents differently); *Jonsson v. StanleyWorks*, 903 F.2d 812, 818, 14 USPQ2d 1863, 1869 (Fed. Cir. 1990) (construction of the same term in related patent relevant to an understanding of that term in patent at issue).

Thus, the lower court and the Federal Circuit both properly rejected the Petitioner's contention that the Enloe II and Enloe III claims somehow recaptured something that the Petitioner was careful to omit from its specification as part of its effort to avoid the prior art Beckestrom reference.

C. Claim 26 Of Enloe II Was Not Directed To Fluid Pervious Flaps

The Petitioner also notes that at one point during the prosecution of Enloe II, the Patent Examiner indicated the claims might be patentable if the flaps were fluid pervious (JA 3803). However, at that time in the prosecution, the Petitioner's response was silence (JA 3803). It did not disagree and contrary to the statement in the Petition, it did not submit a claim to fluid pervious flaps, as the Federal Circuit found when it examined the wording of claim 26 itself (App. 7-8a). Consequently, the Federal Circuit correctly concluded that not only did the doctrine of claim differentiation not apply, but it could not take precedence

anyway in view of the Federal Circuit's established law (App. at 6-7a); *O.I. Corp., supra* at 1582; *Tandon Corp. v. U.S. Int. Trade Commission*, 831 F.2d 1017, 1024 (Fed. Cir. 1987), which law the Petitioner also does not address in its Petition. As a result, the Federal Circuit's decision is consistent with the principles of claim construction established by the law of the Federal Circuit, which apply to the facts of this case.

D. The Federal Circuit Properly Interpreted The Claims Copied As A Result Of The Interference

The Petitioner's last attempt to eliminate the disclaimer of fluid impervious flaps in two of its Enloe specifications is to assert that the Enloe II and Enloe III claims should be interpreted in light of Procter & Gamble's Lawson specification which, of course, did not contain the disclaimer of fluid impervious flaps found in all the Enloe specifications. In fact, the Petitioner maintains that the Federal Circuit's failure to interpret the Enloe II and Enloe III claims as covering fluid impervious flaps in light of the Lawson specification is contrary to the Federal Circuit's holding in *In re Spina*, 975 F.2d 854, 856 (Fed. Cir. 1992) (Petition at 19).

The Petitioner, however, relies on a statement in *In re Spina* that the copied claim is viewed in the "context" of the application from which it is copied and converts that into a new rule of claim construction which requires the copied claim to be interpreted based on the specification from which the claim was copied, regardless of the specification or prosecution history of the application into which the claim is copied. The Federal Circuit in *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328 (Fed. Cir. 2000), has rejected that strained interpretation of *In re Spina*.

The facts in *Cultor* are very similar to those here. In his specification, the inventor described his invention as a product and a process limited to removal of one type of catalyst from edible polydextrose, thereby disclaiming all other processes involving different types of catalysts. As a result of an interference with a third party's patent (which was not limited to a process of using that single catalyst), Cultor copied claims from the third party's patent and won the right to further prosecute those copied claims. Cultor then argued in litigation that the copied claims in its patent should be interpreted broadly (as in the application from which they came) as covering all types of catalysts. The Federal Circuit rejected Cultor's argument (at 1332):

> The claims were copied by *Cultor* from United States Patent No. 5,091,015, a patent assigned to the Warner-Lambert Co. The PTO declared the interference, which was later settled. Since the claims were copied to provoke an interference, Cultor argues that they should be construed as they would be construed in the patent from which they were copied. *Cultor* cites *In re Spina*, 975 F.2d 854, 858, 24 U.S.P.Q.2d 1142, 1145 (Fed. Cir. 1992), in which this court stated: "A claim is not interpreted one way in light of the specification in which it originally was granted, and another way in light of the specification into which it is copied as a proposed interference count." Thus, argues *Cultor*, the term "polydextrose" should be interpreted according to the use of that term in the Warner-Lambert patent.
>
> * * *

> Every patent claim is construed in the context of the specification in which it appears as part of the patent document. When a claim is copied from another patent for interference purposes, it must be supported by the specification of the copier. In *Spina* the application into which the claim was copied was deemed to contain sufficient written description to support the claim, although the structure by which the claimed function was performed was not the same as the structure shown in the specification from which the claim was copied. *The court in Spina did not hold that the copier of a claim for interference purposes thereby acquires the benefit of the descriptive text of the copied patent.*
>
> *The claims to which Cultor demonstrated priority in the interference are construed in light of* ***Cultor's specification****; it becomes irrelevant whether the specific text of the claim was copied from the interfering patent.*

The Federal Circuit then affirmed the district court's ruling that the claims of the Cultor patent were not infringed because of the disclaimer in Cultor's specification which applied to the otherwise broad, copied claims (at 1331). In sum, the Federal Circuit's decision here is not inconsistent with *In re Spina*, but rather, it correctly follows it. The Petitioner's sole response is in footnote 4 of its Petition that this is not a disclaimer case, a contention with which both the district court and the Federal Circuit disagree.

In short, all the Petitioner really disputes here is the conclusion of two courts that it disclaimed fluid impervious flaps in the prosecution of its Enloe patents. If it is a *disclaimer*, the Petitioner does not argue that the decision below was wrong in any way. Instead, the Petitioner insists it is not a disclaimer and the decision below merely involves the arbitrary reading of a limitation from the specification into the claims. The Petitioner then proceeds to attack that faulty premise. This position was properly rejected by the district court, by a panel of the Federal Circuit, and by the Federal Circuit as a whole when it rejected the petition for rehearing en banc.

CONCLUSION

In conclusion, the Federal Circuit's decision is entirely consistent with the decisions of the Federal Circuit and this Court, and the Petition should be denied.

Respectfully submitted,

JOHN M. SKENYON
Counsel of Record
ALAN D. SMITH
FISH & RICHARDSON P.C.
Attorneys for Respondents
225 Franklin Street
Boston, MA 02110
(617) 542-5070